REMARKS

In the Office Action, the Examiner objected to claims 1 and 5 for including various informalities, rejected claims 4, 6-8, and 12-19 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, rejected claims 1-4 and 20-24 under 35 U.S.C. § 103(a) as being unpatentable over NAGAMI et al. (U.S. Patent No. 5,835,710) in view of BORELLA et al. (U.S. Patent No. 6,731,642 B1); and rejected claims 5-19 under 35 U.S.C. § 103(a) as being unpatentable over BORELLA et al. in view of HAN (U.S. Patent No. 6,351,465 B1).

Claims 1-24 were pending in the present application prior to the above amendments. Claims 6, 9, 10, and 19 have been canceled without prejudice or disclaimer, and claims 1, 4, 5, 7, 8, 11-18, 20, and 23 have been amended to improve form. Accordingly, claims 1-5, 7, 8, 11-18 and 20-24 are now pending. Reconsideration and allowance of all claims in view of the following remarks are respectfully requested.

Initially, claims 1 and 5 were objected to for including various informalities. More specifically, claim 1 was objected to for including a "whereby" phrase that the Examiner interpreted as rendering the claim vague and indefinite. Claim 5 was objected to for including improper punctuation. Claims 1 and 5 have each been amended as set forth above to improve form and to overcome the noted objections. Accordingly, reconsideration and withdrawal of the pending objections are respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112

Claims 4, 6-8, and 12-19 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. More specifically,

claim 4 was rejected for including the phrase "assigning a called party number for said session at said first device; and assigning a calling party number for said session at said second device." The Examiner indicated that this phrase is not described in the specification in such a way as to reasonably convey to one skilled in the art possession of the claimed invention.

Claim 4 has been amended to clarify that the calling party and called party numbers are identified, rather than assigned. Accordingly, reconsideration and withdrawal of the rejection of claim 4 are respectfully requested.

Claims 6 and 12 were rejected for including the phrase "assigning a temporary calling party address for said session at said first access control manager; and assigning a temporary called party address for said first access control manager." The Examiner indicated that this phrase is not described in the specification in such a way as to reasonably convey to one skilled in the art possession of the claimed invention. Claim 6 has been canceled, and claims 7-8 have been amended to remove any dependency thereupon. Similarly, claim 12 has been amended to remove the above-described phrase. Claims 13, 14, 16, and 17 have also been amended to remove inherent dependencies upon these features. Claim 19 has been canceled. Accordingly, reconsideration and withdrawal of the rejection of claims 6-8 and 12-19 are respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-4 and 20-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over NAGAMI et al. in view of BORELLA et al. Applicants respectfully traverse.

Independent claim 1, as amended, recites a method for providing quality of service in an Internet Protocol (IP) telephony session between a calling party and a called party. The method includes transporting IP telephony media for the session between the calling party and a first device having IP telephony capability and ATM capability. IP telephony media for the session is transported between the called party and a second device having IP telephony capability and ATM capability. An ATM virtual circuit is established for the session between the first device and the second device. The ATM virtual circuit is secured by use of proxy addressing.

A proper rejection under 35 U.S.C. § 103 requires that three basic criteria be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest each and every claim limitation. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The cited combination of NAGAMI et al. and BORELLA et al. fail to disclose or reasonably suggest the combination of features recited in Applicants' claim 1.

In particular, the Examiner admits that NAGAMI et al. fails to teach or suggest securing the ATM virtual circuit by use of proxy addressing (Office Action pg. 4). The Examiner cites BORELLA et al. to remedy this deficiency. However, Applicants respectfully submit that BORELLA et al. likewise fails to disclose or reasonably suggest

the recited limitation. In making the rejection, the Examiner relied on col. 3, lines 35-37 of BORELLA et al. for allegedly disclosing this feature (Office Action, pg. 4). Applicants respectfully submit that this section of BORELLA et al. does not disclose or suggest securing the ATM virtual circuit by use of proxy addressing, as recited in Applicants' claim 1.

At col. 3, lines 35-37, BORELLA et al. discloses:

> Privacy and security concerns are also addressed by the preferred embodiment of the present invention. Through the use of proxy addresses, one side of the call does not have access to the private addresses of the other side.

This section of BORELLA et al. (as well as surrounding portions) discloses that address translation may be performed on each side of an IP telephony call to keep actual IP addresses secret and secure. As disclosed in col. 4, lines 52-56, network address translation (NAT) can be performed on exchanged data packets. The NAT translates source and destination addresses from the address space of one network to that of the other. BORELLA et al. does not disclose or suggest using proxy addressing to secure the ATM virtual circuit, as recited in Applicants' claim 1. Rather, the translation of BORELLA et al. relates specifically to conventional IP address translation for IP networks. For at least this reason, claim 1, as amended, is patentable over the cited NAGAMI et al. and BORELLA et al. references.

Claims 2-4 depend from claim 1. Accordingly these claims are patentable over NAGAMI et al. and BORELLA et al. for at the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claims 2-4 are respectfully requested.

Regarding claims 20-24, Applicants note that the Examiner continues to fail to provide a separate analysis for independent claim 20. More specifically, no indication is provided where any of the claim elements recited in claim 20 may be found in either NAGAMI et al. or BORELLA et al. Claim 20, as presented, recites significantly different features than those recited in independent claim 1, which was addressed by the Examiner. In particular, claim 20 recites a system for providing a quality of service IP telephony session between a calling party and a called party. The system includes a first device connected between an IP network and an ATM network, where the first device provides bidirectional translation between IP media traffic and ATM traffic. A second device is connected between the IP network and the ATM network, the second device providing bidirectional translation between ATM traffic and IP media traffic. An intelligent control layer is provided for establishing a virtual circuit through the ATM network for an IP telephony session between the calling party and the called party, wherein the first device and the second device are assigned on a per session basis.

Clearly, the rejection of claim 1 can not apply to the language of claim 20. More specifically, the Examiner fails to point out where either NAGAMI et al. or BORELLA et al. teach or suggest an intelligent control layer for establishing a virtual circuit through the ATM network for an IP telephony session between the calling party and the called party, wherein the first device and the second device are assigned on a per session basis. No discussion of this feature is made whatsoever. Therefore, a prima facie case of obviousness under 35 U.S.C. §103 has not been made.

For at least the foregoing reasons, Applicants submit that claim 20 is patentable over the cited combination of NAGAMI et al. and BORELLA et al., either alone or in any reasonable combination.

Claims 21-24 depend from claim 20. Therefore, these claims are considered patentable over the cited combination of NAGAMI et al. and BORELLA et al. for at least the reasons given above with respect to claim 20.

Claims 5-19 were rejected under 35 U.S.C. § 103(a) as unpatentable over BORELLA et al. in view of HAN. Applicants respectfully traverse.

Independent claim 5, as amended, recites a method of providing quality of service in an IP telephony session between a calling party and a called party. The method includes assigning a temporary IP proxy address to the called party at a first access control manager. A temporary IP proxy address is assigned to the calling party at a second access control manager. A switched virtual circuit for the session is established between the first access control manager and the second access control manager. IP media traffic is routed from said calling party to said called party IP proxy address at said first access control manager. IP media traffic is routed from said called party to said calling party IP proxy address at said second access control manager. IP media traffic received at said called party IP proxy address is translated to ATM traffic for transport through said virtual circuit from said first access control manager to said second access control manager. IP media traffic received at said calling party IP proxy address is translated to ATM traffic for transport through said virtual circuit from said second access control manager to said first access control manager. The cited combination of

BORELLA et al. and HAN fails to disclose or reasonably suggest the combination of features recited in Applicants' claim 5.

For example, neither BORELLA et al. nor HAN discloses or suggests translating the IP media traffic received at said called party IP proxy address to ATM traffic for transport through said virtual circuit from said first access control manager to said second access control manager and translating the IP media traffic received at said calling party IP proxy address to ATM traffic for transport through said virtual circuit from said second access control manager to said first access control manager. The Examiner admits that BORELLA et al. does not disclose these features (Office Action, pg. 6). The Examiner cites HAN to remedy this deficiency. However, Applicants respectfully submit that HAN likewise fails to disclose or reasonably suggest the recited features. In making the rejection, the Examiner relied on col. 5, lines 25-31 of HAN for allegedly disclosing the claimed features (Office Action, pg. 6). Applicants respectfully submit that this section of HAN does not disclose or suggest translating received IP media traffic into ATM traffic for transport through the virtual circuit, as recited in Applicants' claim 5.

At col. 5, lines 25-31, HAN discloses:

> ...the IP originating and destination addresses are translated into the ATM addresses of their direct routers, a direct router is the router attached directly to a host or an end point. In the illustrated example, the IP source address is **24** and the IP destination address is **HT 26** and the cut-through path is created between ingress switch/router **22** and egress switch/router **24**.

This section of HAN discloses that the IP addresses for the end users (24 and 26) are translated into the ATM address of their directly attached routers, thus enabling creation of a cut-through path that avoids ATM routers through use of virtual paths. Clearly, this is not analogous to translating received IP media traffic into ATM traffic for

transport through the virtual circuit, as recited in Applicants' claim 5. For at least this reason, claim 5 is patentable over the cited combination of BORELLA et al. and HAN. Reconsideration and withdrawal of the pending rejection is respectfully requested.

Claims 6, 9, and 10 have been canceled and claims 7, 8, and 11 are dependent on claim 5. Accordingly, these claims are patentable over BORELLA et al. and HAN for at the reasons set forth above with respect to claim 5. Reconsideration and withdrawal of the rejection of claim 7, 8, and 11 are respectfully requested.

Independent claim 12 recites features substantially similar to claim 5. Accordingly, claim 12 is patentable over the cited combination of BORELLA et al. and HAN for at least reasons similar to those recited above, with respect to claim 5. Claim 19 has been canceled and claims 13-18 depend from claim 12. Accordingly these claims are patentable over BORELLA et al. and HAN for at the reasons set forth above, with respect to claim 12. Reconsideration and withdrawal of the rejection of claim 13-18 are respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectfully submitted,

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